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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,724	07/28/2003	Timothy Effrem	MAS001	3513

7590 09/30/2008  
THE LAW OFFICES OF ROUZ TABADDOR, ESQ.  
1745 PENNSYLVANIA AVE. N.W.,  
SUITE #205  
WASHINGTON, DC 20006

EXAMINER
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GATES, ERIC ANDREW

ART UNIT	PAPER NUMBER
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3726

MAIL DATE	DELIVERY MODE
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09/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/627,724	EFFREM, TIMOTHY	
	<b>Examiner</b>	<b>Art Unit</b>	
	ERIC A. GATES	3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 13 and 20-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13 and 20-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

1. This office action is in response to Applicant's amendment filed 19 May 2008.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 20-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claim 20, the phrase "a diameter in the range of about 25 mm to above" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the upper limit of the first portion shrouded wall diameter. See MPEP § 2173.05(b). For the purposes of examination, it has been assumed that the diameter upper range is about 27.0 mm as claimed in claim 13.

5. Claim 25 is indefinite because it depends from canceled claim 1. For the purposes of examination, it has been assumed that claim 25 depends from claim 20.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13 and 20-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman (U.S. Patent 1,380,716).

8. Regarding claims 13 and 20-30, Herman discloses a handpiece used with flexible shaft assemblies, the handpiece comprises: a shrouded wall (A) having a first end (ungrooved portion on the left end in figure 1) and a second end (grooved portion on the right end in figure 1) which is adapted to receive the flexible shaft assembly (E), and the shrouded wall has a generally cylindrical shape; a chuck assembly (B/J/K) which is rotatably connected to the interior of the first end of the shrouded wall portion and protrudes out of the shrouded wall so that the jaws (J) of the chuck are able to receive a bit, a first portion (ungrooved portion) of the shrouded wall located at the first end has a diameter; and a second portion (grooved portion) of the shrouded wall located between the first end and the second end includes a plurality of grooves or ridges (portion A as seen in figure 1), the diameter of the second portion is less than the diameter of the first portion (at least in the insides of the grooved portions of the second portion have a diameter less than the first ungrooved portion as seen in figure 1), and wherein the chuck includes a plurality of jaws (j') which are able to secure a bit.

Herman does not disclose that a first portion of the shrouded wall located at the first end has a diameter in the range of about 25.5 mm to about 27.0 mm, a second portion of the shrouded wall has a diameter in the range of about 25.2 mm to about 25.6 mm, the chuck has an effective capacity up to 6.35 mm, wherein the length of the first portion is in the range of 35 mm to 45 mm, wherein the length of the first portion is 40 mm, wherein the diameter of the first portion is 26 mm, wherein the thickness of the shrouded wall is in the range of 0.7 mm to 1.2 mm, wherein the thickness of the shrouded wall is 0.7 mm to 0.8 mm, wherein the second portion has a length in the range of 40 mm to about 85 mm, wherein the second portion has a length of 62 mm, wherein the second portion has a diameter of 25.4 mm. However, it would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to have selected whatever sizes were desired for the shroud for the purpose of matching the shroud size to the desired handpiece size, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges or values involves only routine skill in the art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC A. GATES whose telephone number is (571)272-5498. The examiner can normally be reached on Mon-Thurs 8:45 - 6:15.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric A. Gates/  
Examiner, Art Unit 3726  
26 September 2008